

### **REMARKS**

Claims 1-2, 4-5, 7, 9, 17, 29-30, and 48-60 are pending in this application. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claims 1, 29, and 30 have been rewritten to further clarify the embodiments of the present invention recited therein. In addition, various dependent claims have been rewritten to maintain consistency with the language now recited in the independent claims.

As no new matter has been added, Applicants respectfully request entry of these remarks at this time.

### **THE REJECTION UNDER 35 U.S.C. §§ 102 & 103**

Claims 1, 2, 4-5, 7, 9, and 17 were rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,548,618 to Sullivan *et al.* for the reasons provided on pages 2-4 of the Office Action. In addition, the Examiner rejected claims 30 and 55-57 under § 103(a) as being obvious over Sullivan as provided on pages 4-5 of the Office Action. The Examiner also rejected claim 54 under § 103(a) as obvious over Sullivan in view of U.S. Patent No. 4,288,586 to Bock *et al.* as stated on pages 5-6 of the Office Action. Finally, claims 29, 48-53, and 58-60 were rejected under § 103(a) as obvious over Sullivan in view of U.S. Patent No. 6,174,984 to Peter as provided on pages 6-7 of the Office Action.

According to MPEP § 2136.05, a 35 U.S.C. § 102(e) rejection, or a § 103(a) rejection based on a § 102(e) reference, can be overcome by antedating the filing date of the reference by submitting an affidavit or declaration under 37 C.F.R. § 1.131. MPEP § 2136.05. In light of this instruction, Applicants respectfully submit that Sullivan is not prior art to the present invention as defined under 35 U.S.C. § 102(e). In particular, the subject matter of the present application was conceived of prior to the April 25, 2001 filing date of the Sullivan reference.

In support of this position, Applicants attach herewith the Declaration of Inventors Under 37 C.F.R. § 1.131 ("Inventor Declaration"), as well as supporting documentation. A similar version of this declaration was previously submitted as the Kuntimaddi Declaration with a Response to Final Office Action filed on August 8, 2005 ("Aug. 8, 2005 Response"). As explained in the Aug. 8, 2005 Response, the originally submitted Kuntimaddi Declaration

was intended to demonstrate conception and reduction to practice of the invention, as presently claimed, before the October 1, 1999 effective filing date of the Kennedy patent (previously cited against the claims), which is well before the April 25, 2001 effective filing date of Sullivan. However, based on the Examiner's concerns regarding the Kuntimaddi Declaration stated on pages 8-9 of the Office Action, the Declaration has been rewritten and signed by all inventors to comply with MPEP § 715.04.

In response to the Examiner's statements regarding the requirement for actual evidence of lab results needing to be supported by original documentation from a lab notebook, MPEP § 715.07 states that "[a]n accompanying exhibit need not support all claimed limitations, provided that the missing limitation is supported by the declaration itself." MPEP § 715.07 (citing *Ex Parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989)). In fact, this section of the MPEP begins with the instructions that "[t]he essential thing to be shown under 37 C.F.R. § 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact." *Id.* In any event, if the Examiner is referring to the table appearing on page 4 of the invention record as to the need for further documentation, it is important to note that these test results are not even being relied upon to show conception and reduction to practice.

In fact, the remaining portions of the invention record of Exhibit A declaration adequately provide evidence of conception and reduction to practice without further documentation. For example, Exhibit A includes an invention record setting forth details of a RIM process using low viscosity materials, *i.e.*, isocyanates and polyols, polyamines, epoxies, for fast-reacting polyurethane systems to produce golf ball components. However, the Inventor Declaration now also includes a summary of a trip to Bayer where the testing described in the invention was performed at the request of the inventors (under a Confidentiality Agreement). *See* Exhibit B. As such, Exhibit A demonstrates that the invention recited in the pending claims was conceived and reduced to practice prior to the filing date of the Kennedy and Sullivan references.

In light of the Inventor Declaration, Applicants respectfully submits that, since Sullivan is not prior art under 35 U.S.C. § 102(e), the rejections under 35 U.S.C. §§ 102(e) and 103(a) based thereon have been overcome. Furthermore, because Sullivan is not available as prior art to the present invention, the secondary references alone, or in any combination, do not support a proper anticipation or obviousness rejection. In fact, the Examiner appears to cite Bock to remedy Sullivan's silence with regard to the percent of isocyanate groups in a polyisocyanate. Likewise, Peter is cited merely for its disclosure of

low free isocyanate monomers. None of these references disclose or suggest the present invention. As such, Applicants respectfully request that the §§ 102 and 103 rejections be reconsidered and withdrawn.

### CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response three months to and including December 15, 2006. In addition, a Request for Continued Examination is submitted herewith with authorization to charge the appropriate fee. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Bingham McCutchen LLP Deposit Account No. 195127, Order No. 20002.0350.

Respectfully submitted,  
BINGHAM McCUTCHEN LLP

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